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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,133	01/19/2001	Jonathan E. Lowther	42390P10893	9485
21906	7590	07/28/2005		
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			EXAMINER RAMAN, USHA	
			ART UNIT 2617	PAPER NUMBER

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/766,133

Applicant(s)

LOWTHERT ET AL.

Examiner

Usha Raman

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-7-05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Arguments***

1. Applicant's arguments filed May 6<sup>th</sup>, 2005 have been fully considered but they are not persuasive.

Applicant argues that Zigmond does not provide a caching system that would enable the decision about how to fit the advertisement into the content. However, the examiner asserts that it is the processing unit and not the caching system that enables the decision about how to fit the advertisement into the content. This step is taught by Zigmond in column 6, lines 50-53, and lines 63-67. The caching system itself is used simply to store content media and advertisements.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 27-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 27 recites the limitation, "a shell, in said receiver, to find a place to insert...". While applicant's specification discloses that the methods for inserting advertisements in a program maybe represented as "a series of instructions,

routines, firmware or control codes", there is no suggestion in the disclosure that the series of instructions is a shell. Microsoft Press Computer Dictionary defines a shell as, "a piece of software that provides direct communication between the user and the operating system" (see page 10, lines 29-30). A shell differs from an application program in that a shell allows the user to interact with the operating system itself thereby providing a direct user interface to the operating system, while an application program allows the user to interact with the application program through a user interface and the application in turn may interact with the operating system through an API.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US Pat. 6,698,020).

In regards to claim 27, Zigmond discloses a system comprising:

A receiver (80) to receive content and an advertisement (see fig. 5)

A cache coupled to the receiver to store advertisement (86, column 4, lines 21-23, column 15, lines 24-25); and

A shell (program) in the receiver (see column 6, lines 3-5, lines 51-53) to *find a place to insert* advertisement in the cached content *before* the cached content continues to be output for display (i.e. triggering event, indicating insertion point, based on information contained in EPG, see column 4, lines 40-45), the shell to use a content identifier to find a place to insert the advertisement (see column 11, lines 31-35, column 12, lines 47-51).

Zigmond discloses the step of a receiver with recording capabilities, for recording video programming. See column 6, lines 44-46. Zigmond does not disclose that the recording medium for recording the content comprises a cache.

Examiner takes official notice that cache was well known at the time of the invention, as used to store data requiring fast retrieval access.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system to include a cache as the recording medium for recording video programming, thereby enabling fast retrieval of content.

In regards to claim 28, the modified system comprises a shell utilizing an info segment with an interruption point specifier to indicate a point to insert the advertisement in the content (see column 17, lines 24-31).

In regards to claim 29, the modified system comprises a shell utilizing an info segment having a plurality of fields, one field comprising an interruption point specifier to indicate a point to insert the advertisement in the content, another field indicating, permitted ad type specifier, a prohibited ad type specifier (via content ratings, see column 13, lines 48-51).

In regards to claim 30, the modified system comprises a shell utilizing an info segment having an ad entry, wherein the ad entry has plurality of fields (column 11, lines 35-42).

In regards to claim 31, the modified system comprises the cache storing an electronic programming guide having a program identifier (see column 10, lines 64-67, column 11 lines 1-2) and an associated info segment (see column 11, lines 43-47), the electronic programming guide enabling locating the info segment corresponding to a selected program (column 11, lines 43-47, column 12, lines 60-62, lines 47-51).

In regards to claim 32, the modified system comprises a television receiver (see column 6, lines 34-44).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be


calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UR

  
**VIVEK SRIVASTAVA**  
**PRIMARY EXAMINER**